

REMARKS

In the Office Action, claims 71, 73, and 80 were indicated as being allowable if rewritten in independent form. Claim 58 was indicated as having allowable subject matter. Claim 71 has been placed in independent form to include the limitations of claims 67 and 70. Claim 80 has been placed in independent form to include the limitations of claim 74. Allowance of claims 71 and 80 is respectfully requested.

The courtesy extended by Examiner Robert during the telephone conversation of April 4, 2005 is acknowledged with appreciation. During the conversation, the Examiner explained the reasons for withdrawal of certain claims. Also discussed were the objection to and indefiniteness rejection of claim 56.

Claims 56-60 were objected to for informalities and were rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claim 56 has been amended to recite that the support members are "extendable" past the "tissue mass" to indicate the claim is directed to the subcombination (the surgical apparatus). These changes were discussed with the Examiner. Applicants respectfully submit that this amendment overcomes the objection and rejection of claims 56-60. Dependent claim 58 was indicated as being allowable if the indefiniteness rejection is overcome. The foregoing amendment to claim 56 is believed to overcome the rejection and claim 58 is believed allowable.

The Examiner objected to the drawings and specification. The specification had previously been amended to conform to the amendments in the issued parent application (serial no. 09/838,722, filed April 19, 2001). For example, in the Preliminary Amendment filed October 18, 2001, reference to numerals 150 and 155 was deleted. The amendments to the specification herein are believed to overcome the objections as they conform the specification to the drawings. Note further that reference numeral 27 is in Figures 1 and 2, reference numeral 248 is in Figure 23, and reference numeral 126 is in

Figure 5. Reference numeral 224 is mentioned on page 1 designating the skin.

The Examiner contends that the species of Figures 6-28 does not have a surgical apparatus comprising an elongated housing with a tissue piercing element extending from (or distal of) the housing (claims 61, 62 and 75, 77) or means extending from the housing for creating access to the tissue mass as in claim 68. The Examiner further contends that the species does have an electrocautery cutting wire "advanced" by the at least one support as in claims 63-66. Claim 63 has been amended to change "advanced" to "expanded" by the supports as discussed with the Examiner. Thus, claim 63 and dependent claims 64 and 66 read on the elected species. Claim 62 has been amended to depend from Claim 60 and is presented for consideration. Although Applicants submit the present invention in one aspect provides for a tissue piercing element to provide access for the housing, to expedite prosecution, claims 61, 65, 68, 75 and 77 remain withdrawn.

Claims 56, 57, 60, 67, 69, 70, 74, 76 and 78 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 30 of U.S. Patent No. 6,280,450. To expedite prosecution, enclosed with this amendment is a Terminal Disclaimer. Withdrawal of the rejection is respectfully requested.

Claims 56, 59, 60, 74, 76 and 79 were rejected under 35 U.S.C 102 as anticipated by U.S. Patent No. 5,078,716 to Doll. The Doll patent discloses a loop 12 of conductive wire 14, 16 slideably mounted within insulated sheath 18. The loop is covered over a major portion of its circumference by insulating material 26. In the bipolar embodiment, wires 102, 104 are covered by an insulating layer 106, 108. The handle assembly is advanced and retracted to enable the wires 102, 104 to be advanced or retracted within the tubular cover sheath 150. The handle enables the loop size to be varied (col. 7, lines 43-44).

The Examiner considers "26" as support members, however "26" is insulating material which covers the wire, and does not

support it. Also, the wire 14, 16, appears to cause the insulating material to move.

Claims 56, 59, 60, 67, 69, 70, 74, 76 and 79 were rejected under 35 U.S.C 102 as anticipated by U.S. Patent No. 5,437,665 to Munro. The Munro patent discloses a housing 1 having an insulating outer tube 3. At the distal end of outer tube 3 is wire electrode 7 disposed in part within sheaths 8, 8'. The wire 7 has first and second segments 11, 11" which extend through sheaths 8 and 8' and are connected by bridge segment 12. A pair of leaf springs 9 and 9' are disposed in part in sheaths 8, 8'.

Turning first to independent claim 56, this claim now recites that the cutting loop is subsequently expandable by the diverged support members. Neither Doll nor Munro discloses this feature. At best, in Doll, the wire and insulated layers 102, 104 expand together and in Munro, the sheaths and wire segments expand together. In contrast, in claim 56, first the diverging support members are extendable past a target tissue and then the cutting loop is expandable by the already diverged support members. Withdrawal of the anticipation rejection of claim 56 based on Doll and Munro is therefore respectfully requested.

Claims 57-60 and 62 depend from claim 56 and are therefore believed patentable for at least the same reasons as claim 56 is believed patentable. Note also, the Hart patent, applied against claim 57, does not cure the deficiencies of Munro.

Independent claim 67, as amended, recites that the support means moves independently of the cutting means. This feature is not disclosed in Munro. The sheaths of Munro expand the wire as they expand. Thus, there is no independent movement. Withdrawal of the anticipation rejection of claim 67 in view of Munro is therefore respectfully requested.

Independent claim 74 recites that the elongated members have tissue penetrating tips. This feature is not disclosed in Munro or Doll. Doll terminates in a loop or rounded connector which connects the wires. Munro has a loop at its end. The penetrating tips of the invention of claim 74 facilitate entry of the elongated

members through the target tissue. Withdrawal of the anticipation rejection of claim 67 in view of Doll or Munro is therefore respectfully requested.

Claims 69-70 and 72 depend from claim 67 and are therefore believed patentable for at least the same reasons as claim 67. Claims 76, 78 and 79 depend from claim 74 and are therefore believed patentable for at least the same reasons as claim 74.

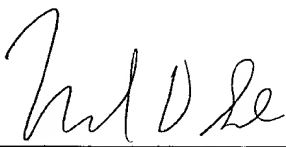
Amended independent claim 63, which reads on the elected species and should be considered, along with its dependent claims 64 and 66, are believed to distinguish over the prior art and allowance of these claims is respectfully requested.

Also mentioned during the telephone conversation with the Examiner was that the IDS filed June 18, 2004 was not initialed by the Examiner. Applicants request return of the initialed PTO Form 1449.

Applicants submit that this application is now in condition for allowance, and allowance of the claims is respectfully requested. Prompt and favorable reconsideration of this application is respectfully requested. The Examiner is invited to contact the undersigned should the Examiner believe it would expedite prosecution.

Respectfully submitted,

Dated: 4/11/05

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